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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/673,689

09/29/2003

Jan Andersson

11285.0021

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22852

7590

07/28/2010

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP

901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

PATEL, NIHIR B

ART UNIT

PAPER NUMBER

3772

MAIL DATE

DELIVERY MODE

07/28/2010

PAPER

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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAN ANDERSSON, ALLAN DAGSLAND,
HANS STRID, JAN TROFAST, STEFAN FRIESS,
HARALD HECKENMUELLER, UWE ROLLWAGE,
VOLKER TIEDEMANN, JOHN CONWAY

Appeal 2009-011471
Application 10/673,689
Technology Center 3700

Before WILLIAM F. PATE, III, STEVEN D.A. MCCARTHY, AND
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Jan Andersson et al. (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 34, 35, 37-39, 41, and 73 under 35 U.S.C. § 103(a) as unpatentable over Coccozza (US 5,033,463, issued Jul. 23, 1991).² We have jurisdiction under 35 U.S.C. § 6(b). We REVERSE.

The Invention

The claims on appeal relate to powder inhaler for administering powder by inhalation.

Claim 34, reproduced below, is illustrative of the subject matter on appeal.

34. A powder inhaler for administering powder by inhalation, comprising:

a dosing unit for providing a dose of powder; and

a flow path downstream of the dosing unit
which is defined by a plurality of surfaces through which a stream of air entraining the dose of powder is in use drawn on inhalation by a user;

characterized in that at least one of the surfaces of the flow path is movable relative to at least one other of the surfaces of the flow path and in that the inhaler further comprises a powder dislodging member which is of fixed position relative to one of the at least one or at least one other of the surfaces of the flow path and is configured on

² The Final Rejection, mailed Mar. 13, 2008, finally rejected claims 34, 35, 37-39, 41, and 73 under 35 U.S.C. § 102(b) as anticipated Coccozza. Final Rejection, pp. 3-4. In response to Appellants' Appeal Brief, the Examiner changed the grounds of rejection to the same claims being rejected under § 103(a) as obvious over Coccozza and denominated the rejection as a new ground of rejection. See Ans. 3 and 7.

relative movement of the at least one and one other of the surfaces of the flow path, to contact the other of the at least one or at least one other of the surfaces of the flow path such as to dislodge powder accumulated thereon,

wherein the powder dislodging member comprises one of a scraper or a brush.

The Rejections

The Examiner posits that “[i]t would have been obvious to one having ordinary skill in the art at the time [of] the invention was made to modify Coccozza’s invention by providing an impeller that comes very close to touching[,] if not touching[,] the surface of the flow path in order to remove the accumulated medicament in the flow path.” Ans. 4.

Contentions

Appellants contend, *inter alia*, that “[i]t would have been understood by anyone of ordinary skill, upon reading Coccozza’s disclosure, that configuring impeller 50 to scrape the wall would be contrary to its intended purpose, by significantly reducing its rotatability.” Reply Br. 2. Moreover, Appellants contend that “[n]or would there have been a clear reason for one of ordinary skill to want to modify Coccozza’s impeller to scrape the wall as suggested, as Coccozza’s impeller is positioned such that the dose of power falls ‘onto the impeller 50’ (Coccozza, col. 7, line 19) and not onto the underlying wall surface.” *Id.*

OPINION

Pertinent Facts

As shown in Figure 1, Coccozza discloses a multi-dose inhaler 1 for medicaments having a unit 16, 50 for mixing the medicament with an air

stream. *See* Abstract. The unit for mixing consists of a mouthpiece 16 and an impeller 50 which is rotatable about its own horizontal axis and located below the door 46. Col. 6, ll. 12-14 and figure 1. In use, the patient inhales through the mouthpiece and thus generates an airstream. This airstream causes the impeller 50 to rotate at a speed so as to mix, “in the best possible manner,” the medicament that has fallen onto the impeller 50. Col. 7, ll. 16-19.

Cocozza teaches a second embodiment that is best depicted in Figure 10. Of particular importance in this appeal is the mouthpiece area 180 having a channel 172. Within the channel 172 is a disintegration device of a “fixed type” consisting of a helically extending channel portion 176 along with a central shaft 186 carrying a coaxial helical element 188. Col. 10, ll. 10-15.

Principles of Law

Where the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, the proposed modification would not have been obvious. *See Tec Air, Inc. v. Denso Mfg. Mich., Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999).

Analysis

On the basis of the findings and legal authority above, Appellants’ position is well taken. Specifically, we find that the Examiner’s proposed modification of Cocozza’s impeller 50 to contact the surface wall would cause difficulty for the impeller to rotate at a speed “in the best possible manner” to mix the medicament into the airstream. Moreover, not having the impeller rotate at a speed “in the best possible manner” as disclosed in Cocozza would likely lead to an improper dose of medicament into the

patient when the patient inhaled through the mouthpiece. Moreover, there is insufficient evidence within the record to make such a proposed modification. Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, an examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967).

It also needs to be noted that the Examiner's rejection appears to be confusing two separate embodiments disclosed in Coccozza. The rejection initially directs attention to unit 2 (shown in figure 10) and then refers to the impeller in figure 1 as reading on the claimed feature of one surface in the flow path being movable to at least one other surface of the flow path. Compare Ans. 3 and 4. As found above, the second embodiment discloses a disintegration device having a fixed type coaxial helical element. Then, Coccozza prophesizes that an impeller could be utilized as a disintegration means. Coccozza, col. 10, ll. 17-18. However, these teachings do not necessarily lead to a finding that the impeller 50 of the first embodiment could be incorporated into the second embodiment and then modified to contact the other flow path surface to dislodge powder accumulated thereon, as set forth in the claims, without more analysis from the Examiner. Substantial modifications would have to be made to the second embodiment and the Examiner fails to articulate what those modifications would entail. When substantial reconstruction and redesign of the elements shown in the primary reference are required, as well as a change in the basic principles, which is likely the case here, under which the construction of the primary

Appeal No. 2009-011471
Application No. 10/673,689

reference was designed to operate in order to reach the claimed features, the claim is likely nonobvious. *In re Ratti*, 270 F.2d 810, 813 (CCPA 1959).

DECISION

In view of the foregoing, the Examiner's decision to reject the claims as obvious over Coccozza as articulated by the Examiner is reversed.

REVERSED

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FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413